UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,870	09/18/2003	Steven Edward Atkin	AUS920030661US1	8464

35525 7590 07/24/2007		EXAMINER
IBM CORP (YA)		NEWAY, SAMUEL G
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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<tr><td rowspan="3">Office Action Summary</td><td colspan="2">Application No.</td><td colspan="2">Applicant(s)</td></tr>
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<tr><td>Examiner</td><td></td><td>Art Unit</td><td></td></tr>
<tr><td></td><td>Samuel G. Neway</td><td></td><td>2626</td><td></td></tr>
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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 May 2007*.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8, and 9-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

1.   This is responsive to the Amendment filed on 23 May 2007.

Response to Amendment

2.   The Objections to claims 3 and 19 are withdrawn in view of the amendments.

3.   The 35 U.S.C § 101 rejections of claims 11 – 16 are withdrawn in view of the

amendments.

4.   The 35 U.S.C § 101 rejections of claims 17 – 20 still stand (see below).

Response to Arguments

5.   Applicant's arguments in regards to the 35 U.S.C § 101 rejections of claims 17 –

20 have been fully considered but they are not persuasive.

Applicant argues that computer program product encoded in a computer-

readable medium, as claimed in claim 17, is statutory because the MPEP states that a

claimed computer-readable medium encoded with a computer program is statutory.

However, there is a difference between a claimed *computer program* encoded in a

computer-readable medium and a claimed *computer-readable medium* encoded with a

computer program. The first is non-statutory because the claim is directed to a

computer program per se, regardless of where it is encoded; on the other hand, the

second, directed to a computer-readable medium, is statutory as long as the computer-

readable medium is statutory, i.e. an article of manufacture.

Furthermore, Applicant argues that a computer-readable medium may

encompass transmission-type media and still be statutory. In the Interim Guidelines,

which are based on the USPTO's current understanding of the law, it is stated that

"Claims that recite nothing but the physical characteristics of a form of energy, such as

a frequency, voltage, or the strength of a magnetic field, define energy or magnetism,

per se, and as such are nonstatutory natural phenomena. O'Reilly, 56 U.S. (15 How.) at

112-14. Moreover, it does not appear that a claim reciting a signal encoded with

functional descriptive material falls within any of the categories of patentable subject

matter set forth in § 101" (Interim Guidelines, page 55). Therefore, it is the USPTO's

position that a claim directed to a computer-readable medium encompassing

transmission-type media (signal) is non-statutory.

6.   Applicant's arguments in regards to the 35 U.S.C § 102 and 35 U.S.C § 103

rejections with respect to claims 1 – 20 have been considered but are moot in view of

the new ground(s) of rejection.

Claim Objections

7.   Claim 1 is objected to because of the following informalities: in line 4, it is

believed that "the data processing system, translating the text from the source language

to the target language" should read 'a data processing system, translating the text from

the source language to a target language'.

Claims 11 and 17 are objected to because of the following informalities: in line 6

and , it is believed that "translating the text from the source language to the target

language" should read 'translating the text from the source language to a target

language'.

Claim Rejections - 35 USC § 112

8.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

9.   Claims 1 – 20 are rejected under 35 U.S.C. 112, second paragraph, as being

indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention.

Independent claims 1, 10, 11, and 17 recite "automatically inserting the

translated text into a user interface ... wherein the inserting step is initiated in response

to another user input". It is unclear how the insertion step can be automatic and initiated

in response to a user input. If the insertion is initiated by a user input then the insertion

is not automatic but is rather controlled by the action of the user. The Examiner will not

take the automatic insertion into consideration for examining purposes herein below.

Claim Rejections - 35 USC § 101

10.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of
> matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the
> conditions and requirements of this title.

11.   Claims 17 – 20 are rejected under 35 U.S.C. 101 because the claimed invention

is directed to non-statutory subject matter.

Claims 17 – 20 are directed to a computer program product, which may be reasonably interpreted as being computer listings per se.

Computer programs claimed as computer listings per se, i.e., the descriptions or expressions of the programs, are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed. Such claimed computer programs do not define any structural and functional interrelationships between the computer program and other claimed elements of a computer, which permit the computer program's functionality to be realized. In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory.

Also, the computer readable medium recited in claims 17 – 20, in accordance with Applicant's specification, may be an electromagnetic signal. This subject matter is not limited to that which falls within a statutory category of invention because it is not limited to a process, a machine, a manufacture, or a composition of matter. Instead, it includes a form of energy, which does not fall within a statutory category.

Amending the claims to recite " A recordable-type media encoding a computer program product" would overcome these rejections in a manner consistent with Applicant's specification.

Claim Rejections - 35 USC § 103

12.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

13.   Claims 1 – 7, and 9 – 20 are rejected under 35 U.S.C. 103(a) as being

unpatentable over See et al (USPN 5,572,668) in view of Chou (USPN 5,583,761).

Claim 1:

See discloses a method for testing a software program (Abstract), the method

comprising the computer implemented steps of:

responsive to a user input containing text in a source language, entered by a

user through a computer interface in a data processing system ("test script 40 is

generated by a user", col. 5, lines 23-25, see also Fig. 4, item 60 and related text),

translating the text from the source language to a target language to form translated text

("translator 42 translates the ... test script" col. 5, lines 31-33).

However, See does not explicitly disclose displaying the translated text.

Chou, in a method for displaying program presentations in different languages,

translates text from a source language to a target language, similar to See's method,

and displays the translated text ("The user can also view the application specific

translation table", col. 3, lines 16-18, see also Fig. 1, item 26).

It would have been obvious to one with ordinary skill in the art at the time of the invention to display the translated text in See's method in order to make corrections to the machine translation (Chou, "If the default translation is not satisfactory, the user can substitute words or phrases", col. 3, lines 18-21).

See further discloses inserting the translated text into a user interface of the software program to be tested to form inserted, translated text, wherein the software program is written in the target language ("The selected NLS script is executed by the localized computer program ... and generates NLS results", col. 6, lines 10-13, see also Fig. 3, item 50 and related text).

However, See does not explicitly disclose where the text insertion is in response to another user input.

Chou discloses an option for a user to select or enter new translations before these translations are sent for further processing (Chou, "taking different selections or entering new words", col. 3, lines 18-21).

It would have been obvious to one with ordinary skill in the art at the time of the invention to insert the translated text in response to another user input in See's method in order to make corrections to the machine translation before the translations are sent to the testing process (Chou, "If the default translation is not satisfactory, the user can substitute words or phrases", col. 3, lines 18-21).

See further discloses determining whether the software program functions correctly using the inserted, translated text (col. 2, lines 13-15).

Claim 2:

See and Chou disclose the method of claim 1, See further discloses wherein the computer interface includes an option for a user to enable and disable translation of the text ("user selects UNLS options 88 which include a selection of the appropriate character set (e.g. Japanese, Chinese, Thai, English or the like)... ", col. 10, lines 48-53. Note that when the script language and the user selected character set language are the same, the translation is disabled).

Claim 3:

See and Chou disclose the method of claim 1, See further discloses wherein the target language is one of a single-byte language or a multi-byte language (Fig. 3, item 44 and related text).

Claim 4:

See and Chou disclose the method of claim 1, See further discloses wherein the translating step uses a set of translation rules (Fig. 6 and related text. Note that operator M corresponds to a one-to-one translation of an ASCII character whereas operator S corresponds to a semantic translation).

Claim 5:

See and Chou disclose the method of claim 1, See further discloses wherein a set of translation rules may be defined in a configuration file by a user at any time (Figs. 4, 6 and related text. Note that the user can write the script at any time).

Claim 6:

See and Chou disclose the method of claim 1, See further discloses wherein a set of translation rules may be applied upon restarting of the computer interface (Figs. 4, 6 and related text. Note that the user can write the script at any time).

Claim 7:

See and Chou disclose the method of claim 1, See further discloses wherein the translating step comprises: preserving selected source language characters in the text (Fig. 8, item 65 and related text) where selected source language characters are replaced with target language characters ("substituting a predefined "problem" character for the particular English language ASCII character", col. 6, lines 53-56).

Claim 9:

See and Chou disclose the method of claim 1, See further discloses wherein translating step is performed using a set of instructions and configuration files in a network data processing system (col. 3, lines 30-32).

Claim 10:

See discloses a data processing system comprising: a bus system; a memory, wherein the memory contains a set of instructions; and a processing unit (Fig. 1 and related text),

wherein the processing unit executes the set of instructions to perform the method of claim 1 as shown above.

Claims 11, 16:

Claims 11 and 16 are similar in scope and content to claim 1 and are rejected with the same rationale.

Claim 12:

See and Chou disclose the method of claim 11, See further discloses wherein the computer interface includes options for a user to select both a source language and a translation mode at any time (Figs. 4, 6 and related text. Note that the user can write the script with a choice of languages and a choice of operators at any time).

Claim 13:

See and Chou disclose the method of claim 12, See further discloses wherein the translation mode includes a default translation and a look up translation (Fig. 6 and related text. Note that operator M corresponds to a one-to-one translation of an ASCII character (default translation) whereas operator S corresponds to a semantic translation (look-up-translation)).

Claim 14:

See and Chou disclose the method of claim 13, however See does not explicitly disclose a popup window with possible translated text inputs.

Chou discloses a window where possible translated text ("The user can also view the application specific translation table", col. 3, lines 16-18, see also Fig. 1, item 26).

It would have been obvious to one with ordinary skill in the art at the time of the invention to display in a popup window the translated text in See's method in order to make corrections to the machine translation (Chou, "If the default translation is not satisfactory, the user can substitute words or phrases", col. 3, lines 18-21).

Claim 15:

Claim 15 is similar in scope and content to claim 7 and is rejected with the same

rationale.

Claim 17:

Claim 17 is similar in scope and content to claim 11 and is rejected with the same

rationale.

Claim 18:

Claim 18 is similar in scope and content to claim 12 and is rejected with the same

rationale.

Claim 19:

Claim 19 is similar in scope and content to claim 13 and is rejected with the same

rationale.

Claim 20:

Claim 20 is similar in scope and content to claim 2 and is rejected with the same

rationale.

Conclusion

14.   Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G. Neway whose telephone number is 571-270-1058. The examiner can normally be reached on Monday - Friday 8:30AM - 5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R Hudspeth can be reached on 571-272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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SN

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